

## **REMARKS**

### **Amendments and New Claims**

Support for the amendments and the new claims can be found in the specification and/or original claims.

Claim 1 is cancelled without prejudice or disclaimer.

Newly added independent claim 51 is similar to amended claim 2, except for variation in the definitions of  $R_2$  and  $R_3$ .

Newly added independent claim 55 is similar to original claim 2, except for variation in the definition of  $R_5$ , i.e.,  $R_3$  is not H. The prior art references teach only compounds wherein  $R_5$  is H.

Suitable dependent claims are added to each new independent claim.

### **The Section 101 and 112 Rejections**

Claim 1 is cancelled without prejudice or disclaimer.

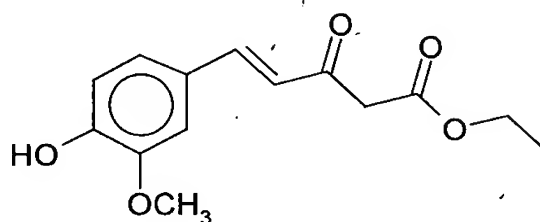
The only remaining issue is whether compounds having as variable X an NH group are enabled. The Office Action alleges that compounds having an NH group as X are not enabled because the specification does not exemplify a compound wherein X is NH. The preparation of said compounds are routine for one of ordinary skill in the art, and thus, their synthesis methods/protocols need not be described in the specification. "A patent need not teach, and preferably omits, what is well known in the art." *Lindemann Maschinenfabrik GMBH v. American Hoist and Derrick Co.*, 730 F.2d 1452, 221 USPQ 481 (CA FC 1984). No undue experimentation is necessary for one of ordinary skill in the art to prepare these compounds. Thus, the claims are enabled.

For additional support that demonstrates that one of ordinary skill in the art is able to place an NH group on a compound that is similar to the ones claimed applicants attach a copy of the Journal of Medical Chemistry, 1991, Vol. 34, No. 4, pages 1503-1505. Applicants bring the attention of the Examiner to Table 1, compound 5 on page 1504.

### **The Section 102 Rejections**

Claims 2, 3, 4, and 5 were rejected as allegedly anticipated by DE 2816819. The amended claims are not anticipated by this reference.

The Office Action alleges that '819 teaches 3-methoxy-4-hydroxy benzylidene malonic acid diethyl ester, methyl-alpha-cyano-3-methoxy-4-hydroxy benzylidene, and ethyl-alpha acetyl-3-methoxy-4-hydroxy benzylidene. Applicants respectfully disagree. A verified translation of the relevant parts of the reference is attached. The reference teaches 4-hydroxy-3-methoxybenzylidenecyanoacetic acid methyl ester, 4-hydroxy-3-methoxybenzylidenemalonic acid diethyl ester, 4-hydroxy-3-methoxybenzylideneacetoacetic acid ethyl ester. The last of the three listed compounds is believed to have the following structure (which is and was not encompassed in the claimed invention):



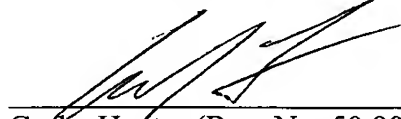
Claims 2, and 3 were rejected as allegedly anticipated by Wang. The amended claims are not anticipated by this reference.

Claims 2, 3, and 4 were rejected as allegedly anticipated by US '233. The amended claims are not anticipated by this reference.

Claims 2, 3, 34 and 37 were rejected as allegedly anticipated by EP '177. The amended claims are not anticipated by this reference.

The Commissioner is hereby authorized to charge any fees associated with this response or credit any overpayment to Deposit Account No. 13-3402.

Respectfully submitted,



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VERIFICATION OF TRANSLATION

I, Melissa Stanford, a translator with Chillson Translating Service, 3530 Chas Drive, Hampstead, Maryland, 21074, hereby declare as follows:

That I am familiar with the German and English languages;

That I am capable of translating from German to English;

That the translation attached hereto is a true and accurate translation of German  
3 formulas from Table 1, reel 909844 frame 0073;

That all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true;

And further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any registration resulting therefrom.

By Melissa Stanford

Executed this 10 day of March 2003.

Witness Anne Chilla

4-Hydroxy-3-methoxybenzylidenecyanoacetic acid methyl ester

✓ 4-Hydroxy-3-methoxybenzylidenemalononic acid diethyl ester

✓ 4-Hydroxy-3-methoxybenzylideneacetoacetic acid ethyl ester

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Tabelle I

	Wellen- länge $\lambda_{\text{max}}$	molare Extinktion $\epsilon$	spez. Extinktion $E_1^1$	Stabilität
2-Methoxybenzylidenyansessigsäuremethylester	354 (297)	10300 (12100)	470 (560)	+
3-Methoxybenzylidenyansessigsäuremethylester	299	15300	710	+
3-Hydroxybenzylidenyansessigsäuremethylester	303	18200	900	-
3-Hydroxybenzylidenmalonsäurediäthylester	282	20300	770	-
4-Methoxybenzylidenyansessigsäuremethylester	340	29300	1350	+
4-Methoxybenzylidenmalonsäurediisobutylester	312	24800	740	+
4-Methoxybenzylidenyansessigsäureamid	332	24300	1200	+
4-Methoxybenzylidenyansessigsäurediisobutylamid	325	15900	510	+
4-Methoxybenzylidenacetessigsäureäthylester	316	19000	770	-
4-Hydroxybenzylidenyansessigsäuremethylester	348	27300	1350	-
4-Hydroxy-3-methoxybenzylidenyansessigsäuremethylester	366	22400	960	-
4-Hydroxy-3-methoxybenzylidenmalonsäurediäthylester	332	20750	630	-
4-Hydroxy-3-methoxybenzylidenacetessigsäureäthylester	340	18200	690	-
3,4-Dimethoxybenzylidenyansessigsäuremethylester	360	24000	970	+
3,4-Dimethoxybenzylidenmalonsäurediäthylester	308	20500	670	+
4-Dimethylaminobenzylidenyansessigsäuremethylester	421	19900	870	-
4-Dimethylaminobenzylidenmalonsäuredimethylester	375	31400	1200	-
4-Dimethylaminobenzylidenmalonsäureamid				-
4-Methacryloxybenzylidenyansessigsäuremethylester	312	23000	1230	-

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translators  
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